

03/30/2004. Applicants have amended Claims 14 and 16, and added Claims 19-21, herewith. Reconsideration of the present patent application is respectfully requested, based on the above amendment to the claims and the following remarks.

### I. DOUBLE PATENTING

The Examiner rejected Claims 1, 4-7 and 10-18 under the judicially created doctrine of double patenting over claims 1-10 of U.S. Patent No. 6,330,621. Applicants are submitting concurrently herewith a terminal disclaimer to overcome such rejection

### II. 35 U.S.C. 103 REJECTION

The Examiner rejected Claims 1, 4-7 and 10-18 under 35 U.S.C. 103(a) as being unpatentable over Allen et al., patent no. 5,546,557 in view of Molin, patent no. 6,111,944. This rejection is respectfully traversed as follows.

With respect to Claim 1, Applicants show that none of references teach or suggest the claimed feature of

means, responsive to a *failure to match* said identified set of data storage characteristics with a single one of said storage set of logical data storage device definitions, for creating a new logical device definition using a plurality of said stored set of logical data storage device definitions

In rejecting Claim 1, the Examiner cited Molin Figure 5; Col. 3, line 50 – Col. 4, line 40; and Col. 6, lines 24-53 as teaching this missing claimed feature. Applicants show that, to the contrary, Molin teaches that if there is a failure to match, the original target (i.e. existing target) definition is used (Molin Col. 4, lines 36-39; Col. 5, lines 40-48). In other words, a failure to match results in using the current target definition, and Molin does not teach or otherwise suggest *creating a new logical device definition* in response to a failure to match, as claimed. This can clearly be seen by Molin's teachings at Col. 4, lines 20-39 where Molin states:

"FIG. 5 is a diagram showing the basic principle of the method of the invention. The diagram shows the measures carried out in the data communication unit of the OMC. At P50, a task arrives at the unit from one exchange for routing the incoming data to the target. The target is given in the target definition. In the data communication unit, there is a substitution table from which all the changes and additions in the installation of the OMC appear. At P52, the table is read to determine which new target corresponds to an old target. At P54, the target definition of all incoming tasks is compared with the substitution table. Provided that the target definition of an incoming task can be found in the table, the table simultaneously gives a new target to which the incoming target definition is reflected. In that case, at P56 the target definition of the incoming task is replaced with a new target definition provided by the table, and at P58 routing takes place on the basis of the data provided by this new target definition. **If there is no target definition for an incoming task in the table, at P60 it is known that replacement, i.e. re-routing is not carried out, at P62 and the original target definition of the incoming task is thus used as a target.**"

This expressly teaches away from the present invention, as Molin teaches that when no match is found, the original target definition is used. In contrast, Claim 1 recites that when there is a failure to match, a new logical definition device is created. Thus, it is shown that every claimed element is not taught or suggested by the cited references. To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added by Applicants). As a *prima facie* case of obviousness has not been properly established by the Examiner, the burden has not shifted to Applicants to rebut an obviousness assertion<sup>1</sup>. In addition, as a *prima facie* case of obviousness has not been properly established with respect to Claim 1, and all other statutory

<sup>1</sup> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

requirements have been met with respect to Claim 1, Applicants are entitled to a patent at least with respect to Claim 1<sup>1</sup>.

Applicants initially traverse the rejection of Claims 4-6 for reasons given above regarding Claim 1, of which Claims 4-6 depend upon.

Further with respect to Claim 5, Applicants show that none of the cited references teach or suggest the claimed feature of "means for creating a new instance of said interconnected ones of said plurality of data storage elements that correspond to said new logical device definition". The Examiner apparently acknowledges that this claimed feature is not expressly taught by either of the cited references, as no citation is given to any such teaching. Instead, the Examiner states that this claimed feature is "inherent" in the teachings of Allen. Applicants show three-fold error in such inherency assertion, as follows.

First, "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)). "To establish inherency," the Federal Circuit recently stated, "the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999); see also *Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Such inherency may not be established by "probabilities or possibilities." *Continental Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (C.C.P.A. 1981)). Applicants show that the claimed feature of creating a new instance of the interconnected ones of the plurality of device elements is not necessarily present in the thing described in the Allen reference (as is required per *In re Robertson*, *supra*), as the Examiner has stated in rejecting Claim 4 that the reference operates to allocate space on an existing instance of the interconnected ones of the plurality of storage device elements. Since it is possible to use an existing instance (as asserted by the Examiner in rejecting Claim 4), there is no requirement to create a new instance, as recited in Claim 5. Thus, this inherency assertion with respect to

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<sup>1</sup> In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See *In re Oetiker*, *supra*.

Claim 5 is shown to be in error, as this missing claimed feature is not necessarily present in the thing described by Allen.

Secondly, in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgirg v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939). The Examiner has not provided any basis in fact or technical reasoning of why this claimed element is inherent, and thus has failed to meet the burden of proof required for such inherency assertion, per *In re King*, *supra*. Claim 5 is thus further shown to have been erroneously rejected by this inherency assertion.

Thirdly, inherency is not proper when rejecting claims under 35 U.S.C. 103, but rather may be proper when rejecting claims under 35 U.S.C. 102. To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). Since all of the claim limitations are not taught or suggested by the cited references, the 35 USC 103 rejection is shown to be improper by the Examiner's assertion that certain missing claimed elements are inherent (which thus acknowledges that this missing claimed element is not taught or suggest by the cited references, thereby failing the all claim limitations rule defined by MPEP 2143.03 with respect to a 35 USC 103 rejection). Thus, Claim 5 is further shown to have been erroneously rejected under 35 USC 103, as an inherency assertion is not proper for a 35 USC 103 rejection.

Further with respect to Claim 6, the sole reason given by the Examiner in rejecting such claim is that the feature recited therein is inherent in the teachings of Allen. For similar reasons to those given above regarding Claim 5, Applicants show that it is improper in a 35 USC 103 rejection to assert that certain missing claimed elements are inherent. Thus, in addition to reasons given above regarding Claim 1 (of which Claim 6 depends upon), Claim 6 is further shown to have been erroneously rejected under 35 USC 103 as an inherency assertion is not proper for a 35 USC 103 rejection.

Applicants traverse the rejection of Claim 7 (and similarly for dependent Claims 10-12) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 11 for similar reasons to those given regarding the further error shown in the rejection of Claim 5 (regarding inherency).

Applicants further traverse the rejection of Claim 12 for similar reasons to those given regarding the further error shown in the rejection of Claim 6 (regarding inherency).

With respect to Claim 13 (and dependent Claim 14), and for similar reasons to those given above regarding Claim 1, Applicants show that none of the cited references teach or suggest the claimed feature of "means, responsive to a failure to match said identified storage attribute with said maintained storage attribute, for creating a new logical data storage device". Thus, Claim 13 (and dependent Claim 14) is shown to have been erroneously rejected under 35 USC 103.

Further with respect to Claim 14, Applicants have amended such claim to clarify the heterogeneous nature of the newly created logical data storage device, and show that none of the cited references teach or suggest the claimed feature of "wherein said new logical data storage device comprises both physical and logical data storage elements". In particular, none of the cited references teach or suggest a logical data storage device that is made up of both physical and logical storage elements. Thus, amended Claim 14 is further shown to not be obvious in view of the cited references.

With respect to Claim 15 (and dependent Claim 16), none of the cited references teach or suggest the claimed feature of "means, responsive to a match of an identified storage attribute, for creating a new instantiation of said logical storage device". In rejecting Claim 15, the Examiner relies upon the reasoning given in rejecting Claim 1. However, Applicants show that Claim 15 is different from Claim 1, in that it recites creating a new instantiation of a logical storage device. Claim 1 does not recite, nor has the Examiner alleged any teaching or suggestion in any cited reference, of "creating a new instantiation" of a logical storage device. Therefore, the Examiner has failed to establish a *prima facie* showing of obviousness with respect to Claim 15 (and dependent Claim 16). Thus, the burden has not shifted to Applicants to rebut obviousness, and since all other statutory requirements have been met, Applicants are entitled to a patent at least with respect to Claim 15 (and dependent Claim 16), per *In re Oetiker*, *supra*.

Applicants further traverse the rejection of Claim 16 for further reasons given above regarding Claim 14.

Applicants traverse the rejection of Claim 17 for similar reasons to those given above regarding Claim 13.

Applicants traverse the rejection of Claim 18 for similar reasons to those given above regarding Claim 15.

Therefore, Applicants have successfully traversed the rejection of Claims 1, 4-7 and 10-18 under 35 U.S.C. 103(a), and requests that such rejection be withdrawn.

### III. NEWLY ADDED CLAIMS

Claims 19-21 have been added herewith. Examination is respectfully requested.

### IV. CONCLUSION

In summary, Applicants have shown error in the Examiner's rejection of Claims 1, 4-7 and 10-18, and requests that the rejection of such claims be withdrawn. Applicant further requests that all pending claims be allowed and that this case pass to issue. If a telephone conference would expedite allowance or resolve further questions, such a conference is invited at the convenience of the Examiner.

Respectfully submitted,  
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